

DOCKET NO: 246235US6

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
MAMORU TOKASHIKI : EXAMINER: LEE, JINHEE J
SERIAL NO: 10/730,138 :
FILED: DECEMBER 9, 2003 : GROUP ART UNIT: 2175
FOR: INFORMATION PROCESSING :
APPARATUS

APPEAL BRIEF UNDER 37 CFR 41.37

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal of the final Office Action dated October 19, 2007. A Notice of Appeal was filed on April 21, 2008.

TABLE OF CONTENTS

I.	Real Party of Interest	2
II.	Related Appeals and Interferences.....	2
III.	Status of Claims	2
IV.	Status of Amendments	2
V.	Summary of Claimed Subject Matter	2
VI.	Grounds of Rejection for Review	7
VII.	Arguments.....	7
VII.	Claims Appendix Of Claims Involved In Appeal.....	13
IX.	Evidence Appendix.....	13
X.	Related Proceedings Appendix	13
	Conclusion	14
	CLAIMS APPENDIX.....	15
	EVIDENCE APPENDIX.....	20
	RELATED PROCEEDINGS APPENDIX.....	21

I. Real Party of Interest

The real party of interest in this appeal is the assignee Sony Corporation of Tokyo, Japan.

II. Related Appeals and Interferences

There are no related interferences.

III. Status of Claims

Claims 1-18 are pending. Claims 1-18 are appealed.

IV. Status of Amendments

An Amendment was filed on August 3, 2007 which resulted in the final Office Action dated October 19, 2007. A Request for Reconsideration was filed on January 22, 2008, which resulted in the Advisory Action dated April 18, 2008.

V. Summary of Claimed Subject Matter

Claim 1, the first of the independent claims appealed, will be treated as a picture claim representing many of the features in the remaining independent claim. Accordingly, a claim chart for support is provided below showing support from the specification for the claim elements.

Claim 1	Support in U.S. Pat. Appl. No. 10/730,138
An information processing apparatus comprising:	<u>Specification, numbered paragraph [0011]</u> : Fig. 1 is a block diagram showing a constitution of an information processing system as a preferred embodiment of the present invention. Such information processing system aims at allowing the user to handle usual information seamlessly among various information processes (it is a system which permits one piece of information to be commonly used between a plurality of information processes).

<p>a room image storage means for storing an image of a structure of a room;</p>	<p><u>Specification, numbered paragraph [0023]</u>: The decoration server apparatus 6 has a database 8 (DB) in which data individually owned by each user are stored.</p> <p><u>Specification, numbered paragraph [0055]</u>: Figs. 4A to 4C show an example of the image of the room. Fig. 4A illustrates an image of a "living room." Fig. 4B shows an image of a "bedroom." Fig. 4C illustrates an image of a "closet." The image of each room may be displayed on a display screen 20 one by one according to the user's operation of the portable phone device 9.</p> <p><u>Specification, numbered paragraph [0079]</u>: As described above, the agent selected by the user is the user's avatar (alter ego). Further, the image of the room selected by the user has the same structure as the user's room or a similar one. Still further, each item installed in the image of the room is installed in the same place (or a desired place) as the user's home. Thus, as to the image displayed on the display screen 20 of the user's portable phone device 9, "an image of a virtually reproduced user's room" may be displayed.</p>
<p>an item image storage means for storing an image of an item to be operated in said room;</p>	<p><u>Specification, numbered paragraph [0020]</u>: The control server apparatus 5 has stored therein information indicating apparatuses such as a television receiver set, a video tape recorder apparatus, an air-conditioner apparatus, a personal computer apparatus, etc. which are owned by each user and installed at the user's home, command information for operating each apparatus by remote control, etc.</p> <p><u>Specification, numbered paragraph [0087]</u>: On the other hand, the portable phone device 9 stores, in the internal memory, each information data which indicates the agent, the room, the item and its installation location which are selected by the user and transmits it to the mobile server apparatus 11. The mobile server apparatus 11 stores the each information data in the database 31.</p>
<p>a display control means for controlling display of a first image on a display means by reading said image of said item selected by a user from said item image storage means while reading said image of said room selected by said user from said image storage means,</p>	<p><u>Specification, numbered paragraph [0057]</u>: The image of any room as well as an image YR of a rightward arrow, an image YL of a leftward arrow, and the names (letters) of the rooms to be changed and displayed are displayed on the display screen 20 of the portable phone device 9. The image YR of the rightward arrow and the name of the room to be changed and displayed indicate the room to be changed and displayed when the right key 22R is depressed. The image YL of the leftward arrow and the name of the room to be changed and displayed indicate the room to be changed and displayed when the left key 22L is depressed.</p>

	<p><u>Specification, numbered paragraph [0066]</u>: Next, in step S6, since the desired room has been selected by the user, the CPU of the portable phone device 9 displays the image of each item on the display screen 20, based on the application program.</p> <p><u>Specification, numbered paragraph [0069]</u>: From the item images thus displayed one by one, the user selects an item installed in the selected room or an item desired by the user to be installed by depressing the jog dial 21, for example.</p> <p><u>Specification, numbered paragraph [0074]</u>: Next, the user installs the selected item in a desired position in the room. For example, as for the position, in the room, where the item may be installed, several installation locations are defined in advance for each item. When the jog dial 21 is rotated in a status where the preliminary selection screen is displayed, according to the rotation operation of the jog dial 21, the CPU of the portable phone device 9 moves and displays the item currently selected (in this case, the personal computer apparatus 30a) to the pre-defined installation locations.</p> <p><u>Specification, numbered paragraph [0075]</u>: When the item is displayed at a desired installation location among the installation locations where the item is thus moved and displayed, the user depresses the jog dial 21. Then, as shown in Fig. 7B the CPU of the portable phone device 9 moves and displays the personal computer apparatus 30a which is the selected item in this case, as if it were floating in the room, so as to install and display it in the selected installation location as shown in Fig. 7C.</p> <p><u>Specification, numbered paragraph [0077]</u>: Next, the CPU of the portable phone device 9 displays, for example, a message "continue item selection?" each time an item is arranged. In step S9, according to the message, the CPU of the portable phone device 9 determines whether or not the user has performed the operation (continuation operation) which requires to continue the arrangement of the item. When the continuation operation has been carried out by the user, the process is returned to step S7, the image of each item transmitted from the mobile server apparatus 11 is displayed again, and the user is prompted to select a desired item. When an item is selected by the user, the item is displayed at a specified location in the room.</p>
--	--

<p>and forming said first image such that said image of said item is incorporated in said image of said room,</p>	<p><u>Specification, numbered paragraph [0079]:</u> On the other hand, when the continuation operation has not been carried out by the user (when the user has issued instructions to terminate the device selection), the portable phone device 9 stores each of the information data indicating the agent, the room, the item and its installation locations (for example, the X, Y coordinate values, etc.) which are selected by the user in internal memories (or external memory etc.) of the portable phone device 9. While, an image into which the agent and each of the items selected by the user are incorporated is formed in the room selected by the user so as to be displayed on the display screen 20 as a selection screen. Thus, all processes as shown in the flow chart of Fig. 2 are completed.</p> <p><u>Specification, numbered paragraph [0080]:</u> With respect to the room selected by the user, Figs. 8A to 8C show examples of images into which the agent and each item selected by the user are incorporated. Fig. 8A is an image of the "living room." The image of the "living room" is formed by the angel type agent, the television receiver set 30i, the personal computer apparatus 30a, the scrapbook 30f, the message function 30g, etc., which are selected by the user.</p>
<p>said display control means configured to transmit information over the Internet to communicate with said item to be operated.</p>	<p><u>Specification, numbered paragraph [0028]:</u> The communications server apparatus 7 obtains, for example, "news (or information on the Internet)", such as weather information, a timetable of a train or a bus, constellation fortune-telling, stock quotations, and position information from the predetermined site on the Internet so as to store the news in the database 18. These information data are provided to each user's personal computer apparatus through the Internet 4, and also provided to the mobile device such as the portable phone device through a mobile server apparatus 11.</p> <p><u>Specification, numbered paragraph [0040]:</u> Based on remote control by the portable phone device 9, the control server apparatus 5 of the server system 1 controls each of the devices to be remotely controlled, through the Internet 4 and the domestic network 17.</p> <p><u>Specification, numbered paragraph [0088]:</u> The mobile server apparatus 11 transmits information indicating a device, such as the television receiver set, out of the information data indicating respective items together with the user's "user ID" and "password" through the Internet 4 to the control server apparatus 5.</p>

In order to satisfy the requirements of 37 C.F.R. 41.37(c)(vii), the following means elements are listed in the claim chart below.

room image storage means	the CPU of portable phone device 9; control server apparatus 5; decoration server apparatus 6; communication server apparatus 7, mobile server apparatus 11, databases 18, 8, 18, 31
item image storage means	the CPU of portable phone device 9; control server apparatus 5; decoration server apparatus 6; communication server apparatus 7, mobile server apparatus 11, databases 18, 8, 18, 31
display control means	the CPU of a mobile device, such as a personal computer apparatus; an apparatus of high information processing performance; a PHS telephone (PHS: Personal Handyphone System); a PDA device (PDA: Personal Digital Assistant); or other apparatuses such as a portable type personal computer apparatus (notebook type etc.) equipped with the communication function may be used as a client terminal
display means	display of a mobile device, such as a personal computer apparatus; an apparatus of high information processing performance; a PHS telephone (PHS: Personal Handyphone System); a PDA device (PDA: Personal Digital Assistant); or other apparatuses such as a portable type personal computer apparatus (notebook type etc.) equipped with the communication function may be used as a client terminal

Claim 10 defines an apparatus which recites features similar to Claim 1, however, without using language which invokes 35 U.S.C. § 112, sixth paragraph. Thus, the features of Claim 10 are supported in the specification by numbered paragraphs [0011], [0020], [0023], [0028], [0040], [0055], [0057], [0066], [0069], [0074], [0075], [0077], [0079], [0080], [0087], and [0088] as listed in the first claim chart above.

VI. Grounds of Rejection for Review

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Naughton et al. (U.S. Pat. No. 6,344,861, hereinafter “Naughton”) in view of Cunningham et al. (U.S. Pat. Pub. No. 20020011923, hereinafter “Cunningham”).

VII. Arguments

Regarding the 35 USC § 103 Rejection over Naughton, and Cunningham for Claims 1-7 and 10-16

Claim 1 recites an information processing apparatus comprising:

a room image storage means for storing an image of a structure of a room;

an item image storage means for storing an image of an item to be operated in said room;

a display control means for controlling display of a first image on a display means by reading said image of said item selected by a user from said item image storage means while reading said image of said room selected by said user from said image storage means, and forming said first image such that said image of said item is incorporated in said image of said room, said display control means configured to transmit information over the Internet to communicate with said item to be operated.

The Office Action acknowledges on page 2 that Naughton does not disclose said display control means configured to transmit information over the Internet to communicate with said item to be operated, and relies on Cunningham to overcome this deficiency.

Indeed, Naughton does not use the Internet to remotely operate selected devices. Instead, the communication in Naughton takes place using radio waves, low power, cellular, infrared signals, or electrical signals on existing power lines in the case of an Echelon ® base LON® system. There is no mention in Naughton of any communication over an Internet network. Further, the remote control system in Naughton is primarily intended for use with “intelligent remote devices” 150, which are specifically designed to operate with the hand-

held display device 170, and which broadcasts across the communications network 160 that it has a user interface program object to export. See Naughton Figure 20 and column 26, lines 8-13.

Therefore, Naughton suggests that use over the Internet is not intended, nor possible, as communication takes place directly between the device to be controlled and the remote control itself using the protocols of those devices. As detailed below, the “intelligent remote devices” in Naughton do not constitute a disclosure of communication over the Internet, and indeed *teach away* from the use of Internet-based communication.

If the communications in Naughton were somehow placed on the Internet, the protocol of the information being transmitted in the intelligent remote devices would have to first be reformatted for Internet transmission and later be converted back to the required protocols for the local devices. While such steps *may* be possible, these steps represent technological difficulties which would dissuade one of ordinary skill in the art at the time of the invention from modifying Naughton to use Internet transmission.

More specifically, Naughton is backward compatible with non-intelligent remote devices, referred to as “simple remote devices” and conventional electronic devices. Control of such devices do not use the Internet. To control the simple remote device 155 of Naughton, the display device 170 invokes a method within the device driver object 351 to translate the user's interactions into simple predefined control codes; the display device 170 then transmits the simple predefined control codes to the simple remote device 155 which receives the control codes through receiver 421 and passes the information to the device control circuitry 425. See Naughton column 9, lines 38-45.

Furthermore, the conventional electronic devices in Naughton are controlled by transmitted signals such as infrared signals. See Naughton column 9, lines 47-48. Again, this further suggests that use over the Internet was not intended, nor possible, as

communication takes place directly between the device to be controlled and the remote control itself using pre-established control codes which at least would have to be appropriately converted for Internet transmission and then subsequently transformed to the control code protocols. Furthermore, the intelligent remote devices may broadcast information in a format only known to the device manufacturers and therefore 1) may not be available or 2) may not be compatible with an Internet protocol.

Cunningham describes *a stationary display* that operates over existing power lines 25 or 27, whereby two or more devices can communicate *over common power lines within a building*.

Moreover, the communication in Cunningham between a control and an item to be operated takes place over existing power lines 25 or 27 and by way of bridge device 70, and not by communication over the Internet. The Office Action states on page 3 that Cunningham “teaches that the Internet is a form of communications network (see paragraph [0027] for example),” however, this paragraph merely states that “[t]he controllers 50 and 60 may also be coupled *to an external communications network* (e.g., the internet, world wide web) via telephone, DSL or cable TV lines 35 or the like, or via a wireless link such as cellular telephone, satellite or the like.” [Emphasis added]. Later, Cunningham states:¹

The system of the present invention, via *the console 50*, or other such system controller, *can interact with networks such as the Internet* in context-specific and targeted modes that are heretofore unprecedented. Via the console 50, the system of the present invention can *browse the Internet and access information therefrom as a function of the operational state of the system and/or of information gathered by the system*. For example, when a user is accessing a recipe on a recipe website, the user can add all or some of the listed ingredients to a shopping list by pressing the touchscreen next to or on the respective ingredients. Selected ingredients may also have manufacturers' discount coupons attached thereto. Once completed, the user can electronically send the shopping list, with coupons, to an on-line grocer for processing,

¹ Cunningham et al. numbered paragraph [0069].

payment and delivery. ***The list can also be printed*** at a printer coupled to the system (e.g., via the PC 59) ***or uploaded to a PDA via the IR interface 280 or other serial data interface of the console 50.*** Once in the PDA, the list can then be downloaded to a receiving system at a grocery store for processing.

Accordingly, Cunningham contemplates using console 50 as collecting and downloading information from selected websites, and may provide personalized homepages for users to storing personal information such as memos and weight and blood pressure information obtained from devices in the house, such as scale 72 or BP monitor 76. Thus, any actual use of the Internet is a mere transfer of information to a device and is ***not*** used to operate or control a device remotely. Hence, even if the Internet feature of Cunningham is applied to Naughton, then the combination will still fail to produce the claimed transmission of information over the Internet to communicate with said item to be operated. Rather, such a combination would only mean that the remote control system in Naughton is now connected to the outside world by the Internet.

Therefore when considered as a whole, Naughton and Cunningham both ***teach away*** from a control means transmitting information over the Internet to communicate with an item ***to be operated***, as defined in the independent claims. The Court in *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994) stated that:

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, ***or would be led in a direction divergent from the path that was taken by the applicant.*** The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant. [Emphasis added.]

Accordingly, both Naughton and Cunningham ***teach away*** from the claimed invention.

Moreover, the situation here is similar to that in In re Ratti, 270 F.2d 810, 813, 123 USPQ 349, 352 in which the Court reversed an obviousness rejection where the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” Here, direct communication over the Internet in Naughton would change (or eliminate) the basic operating principle in Naughton in which the remote control device functions by transmitting infrared signals which require controlling a device within a line of sight.

For example, the *control devices* in Naughton and Cunningham each perform different functions than the primary function of the claimed device. The function of the individual devices in the respective references differ from the claimed display device in that, for instance, the remote control device in Naughton functions by transmitting infrared signals which by their very nature require controlling a device within a line of sight. On the other hand, the control device in Cunningham, while having the capability of external communications to the network, functions by using the control devices within the house and communicating over power lines 25 or 27 and over bridge device 70. However, in Cunningham, there is no direct communication over the Internet between the controller and the device to be operated. Therefore, neither reference discloses or suggests transmitting information over the Internet to communicate with the item to be operated, as recited in Claims 1 and 10.

Recently published guidelines for the Patent and Trademark Office, published in Federal Register Vol. 72, No. 195, on Wednesday October 10, 2007 entitled: “Examination Guidelines for Determining Obviousness under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International v. Teleflex Inc,” indicate that:

Office personnel should consider all rebuttal evidence that is timely presented by the Appellants when reevaluating any obviousness determination. Rebuttal evidence may include evidence of “secondary considerations,” such as “commercial success, long felt but unsolved needs, [and] failure of others”, and may also include evidence of unexpected results. Office personnel must articulate findings of fact that support the rationale relied upon in an obviousness rejection. As a result, Appellants are likely to submit evidence to rebut the fact finding made by Office personnel. For example, in the case of a claim to a combination, Appellants may submit evidence or argument to demonstrate that:

(1) one of ordinary skill in the art could not have combined the claimed elements by known methods (e.g., due to technological difficulties);

(2) the elements in combination do not merely perform the function that each element performs separately; or

(3) the results of the claimed combination were unexpected.

Once the Appellant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. All the rejections of record and proposed rejections and their bases should be reviewed to confirm the continued viability. The Office action should clearly communicate the Office’s findings and conclusions, articulating how the conclusions are supported by the findings.

Here, Appellant’s rebuttal evidence includes:

- 1) the teaching away of Naughton;
- 2) the technical difficulty required to convert communications from “intelligent remote devices” to Internet protocol;
- 3) the teaching away of Cunningham; and
- 4) the communication elements in Cunningham (including the applied Internet element) performing a different function than in the claimed invention.

Hence, the rejection under 35 U.S.C. § 103(a) based on Naughton and Cunningham for Claims 1-7 and 10-16 should be reversed.

VII. Claims Appendix Of Claims Involved In Appeal

Attached herewith is a Claims Appendix.

IX. Evidence Appendix

There are no items in the attached Evidence Appendix.

X. Related Proceedings Appendix

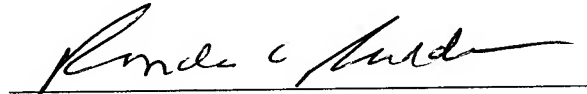
There are no related proceedings listed in the attached Related Proceedings Appendix.

Conclusion

Appellant request on the basis of the arguments presented above that the outstanding grounds for the rejection be reversed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Ronald A. Rudder, Ph. D.
Registration No. 45,618
Attorney of Record
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314
(703) 412- 7033(Direct Dial)
(703) 413-2220 (Facsimile)
RRUDDER@OBLON.COM

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

CLAIMS APPENDIX

1. An information processing apparatus comprising:

a room image storage means for storing an image of a structure of a room;

an item image storage means for storing an image of an item to be operated in said room;

a display control means for controlling display of a first image on a display means by reading said image of said item selected by a user from said item image storage means while reading said image of said room selected by said user from said image storage means, and forming said first image such that said image of said item is incorporated in said image of said room, said display control means configured to transmit information over the Internet to communicate with said item to be operated.

2. The information processing apparatus according to claim 1, further comprising a character image storage means for storing an image of a character, wherein said display control means controls display of a first image on said display means by reading said image of said character selected by said user from said character image storage means, and forming said first image such that said image of said item read through selection by said user and said image of said character read through selection by said user are incorporated in said image of said room selected by said user.

3. The information processing apparatus according to claim 2, wherein said display control means selectively controls by high luminance, display of an outline of a item from a plurality of items incorporated in said first image according to an operation by an operation means.

4. The information processing apparatus according to claim 3, wherein said display control means supplementarily controls display of a function included in said item having the outline thereof displayed by high luminance.

5. The information processing apparatus according to claim 3, wherein said display control means displays said character so as to have said character located in the vicinity of said item having the outline thereof selectively displayed by high luminance.

6. The information processing apparatus according to claim 2, wherein, when an instruction to copy information of a first item to a second item is issued, said display control means controls display of said character in order to pick up a designated object from said first item and place said picked up object on said second item.

7. The information processing apparatus according to claim 6, wherein, when an instruction to copy information of a first item to a second item is issued, said display control means controls display of said character and displays said information of said first item pasted on an input screen of said second item.

8. The information processing apparatus according to claim 1, wherein said display control means is configured to be in communication with the item to be operated through a home network in communication with the Internet.

9. The information processing apparatus according to claim 1, wherein said display control means is configured to be in communication with a control server providing control commands for the item to be operated.

10. An information processing apparatus comprising:

- a room image storage configured to store a structure of a room;
- an item image storage configured to store an image of an item to be operated in said room;
- a display device including a display and a display control configured to display a first image on said display device by reading said image of said item selected by a user from said item image storage while reading said image of said room selected by said user from said image storage, and forming said first image such that said image of said item is incorporated in said image of said room,
- said display device configured to transmit information over the Internet to communicate with said item to be operated.

11. The information processing apparatus according to claim 10, further comprising a character image storage configured to store an image of a character, wherein said display control displays a first image on said display by reading said image of said character selected by said user from said character image storage, and forms said first image such that said image of said item read through selection by said user and said image of said character read through selection by said user are incorporated in said image of said room selected by said user.

12. The information processing apparatus according to claim 11, wherein said display

control selectively displays an emphasized item from a plurality of items incorporated in said first image.

13. The information processing apparatus according to claim 12, wherein said display control supplementarily displays a function included in said emphasized item.

14. The information processing apparatus according to claim 12, wherein said display control displays said character so as to have said character located in the vicinity of said emphasized item.

15. The information processing apparatus according to claim 11, wherein, when an instruction to copy information of a first item to a second item is issued, said display control displays said character in order to pick up a designated object from said first item and place said picked up object on said second item.

16. The information processing apparatus according to claim 15, wherein, when an instruction to copy information of a first item to a second item is issued, said display control displays said character and said information of said first item pasted on an input screen of said second item.

17. The information processing apparatus according to claim 10, wherein said display control is configured to be in communication with the item to be operated through a home network in communication with the Internet.

18. The information processing apparatus according to claim 10, wherein said display control is configured to be in communication with a control server providing control commands for the item to be operated.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.